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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,585	11/15/2001	Avi J. Ashkenazi	P2730P1C41	1273

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HELLER EHRMAN WHITE & MCAULIFFE LLP
275 MIDDLEFIELD ROAD
MENLO PARK, CO 94025-3506

EXAMINER	
DEBERRY, REGINA M	

ART UNIT	PAPER NUMBER
1647	

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,585	ASHKENAZI ET AL.	
	Examiner	Art Unit	
	Regina M. DeBerry	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *119-124* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *119-124* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/30/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Status of Application, Amendments and/or Claims

The amendment filed 15 November 2001 has been entered in full. Claims 1-118 were cancelled. New claims 119-124 were added. Claims 119-124 are under examination.

The information disclosure statement filed 30 May 2002 was received and complies with the provisions of 37 CFR §§1.97 and 1.98. It has been placed in the application file and the information referred to therein has been considered as to the merits. However, Blast results cannot be printed on the face of a patent.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 119-124 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility *for the antibody*. The instant claims are drawn to an isolated antibody that binds to the polypeptide shown in Figure 284 (SEQ ID NO:399), the antibody which is a monoclonal antibody, humanized antibody, antibody fragment and labeled antibody.

The specification teaches that DNA62876-1517 sequence encodes a novel factor designated as PRO1187 (SEQ ID NO:399). The specification states that the cDNA clone (DNA62876-1517) that has been identified encodes a novel polypeptide having sequence identity with endo-beta-1,4-xylanase (page 258, lines 16-22). The specification fails to disclose any information regarding ligands, functional

characteristics/mechanisms of action of PRO1187. The specification proposes a sequence identity with endo-beta-1,4-xylanase. Generally, the art acknowledges that function cannot be predicted based solely on structural similarity to a protein found in the sequence databases. For example, Skolnick *et al.* (2000, Trends in Biotech. 18:34-39) state that knowing the protein structure by itself is insufficient to annotate a number of functional classes, and is also insufficient for annotating the specific details of protein function (see Box 2, p. 36). Karp (1998, Bioinformatics 14:753-754) states that functional annotations are propagated repeatedly from one sequence to the next with no record made of the source of a given annotation, leading to a potential transitive catastrophe of erroneous annotations. Incorrect functional predictions can result from a number of causes, including: divergence of function within homologous proteins, confusion or omission of functions across multimodular proteins or simply choosing the strongest homolog as the source of attributed function.

The specification asserts several utilities. The specification states that antibodies specifically binding a PRO polypeptide can be administered for the treatment of various disorders in the form of pharmaceutical compositions, may be used in diagnostic assays or for affinity purification. The specification states that the PRO polypeptides described herein may be employed as therapeutic agents. The instant invention encompasses methods of screening compounds for PRO agonist and antagonists to identify drug candidates.

In addition, the specification teaches that PRO polypeptide encoding genes are amplified in the genome of certain human lung, colon and/or breast cancers and/or cell

lines. The specification states that amplification is associated with overexpression of the gene product, indicating that the polypeptides are useful targets for therapeutic intervention in certain cancers and diagnostic determination of the presence of those cancers (page 539, lines 20-25). The specification teaches experiments to determine whether the DNA encoding the PRO polypeptide is over-represented in any of the primary lung or colon cancers or cancer cell lines or breast cancer cell line that were screened. Primary lung cancers were obtained from individuals with tumors. The results of the TaqMan are reported in deltaCt units. One unit corresponds to 1 PCR cycle or approximately a 2 fold amplification relative to normal (page 539, lines 26-41). The specification teaches that primary tumor (human lung tumor) LT12, LT15 and LT16 have deltaCt units of 1.17, 1.55 and 1.33 respectively for PRO1187 (page 554).

While the instant specification *may have utility for the polynucleotide*, the instant claims are drawn to the antibody. The increased copy number of DNA does not provide a readily apparent use for the polypeptide, for which there is no information regarding level of expression, activity or role in cancer. Thus the same would hold true for the antibody. The protein is not specific to one tissue or type of tissue and is not associated with any disease or disorder. In addition, protein expression shows a poor correlation with mRNA expression. The Examiner has cited Haynes *et al.* to demonstrate this. Haynes *et al.* (Electrophoresis 19:1862-1871, 1998) studied 80 proteins relatively homogenous in half-life and expression level and found no strong correlation between protein and transcript levels; for some genes, equivalent mRNA levels translated into protein abundances which varied by more than 50-fold. Haynes concluded that the

protein levels cannot be accurately predicted from the level of the corresponding mRNA transcript (page 1863, 2nd paragraph, and Figure 1).

Thus, the claimed invention lacks specific and substantial utility. Diagnostic assays and purifications assays are starting point for further research and investigation to identify or reasonably confirm what the practical use might ultimately be. The assays recited for the anti-PRO antibodies are general utilities that would be applicable to the broad class of the invention. Processes to screen for receptor agonists and/or antagonists are performed for any receptor-ligand pair when the physiological role of each is unknown. Antibodies can be made to any protein. A specific utility is a utility that is specific to the subject matter claimed. This contrasts with a general utility that would be applicable to the broad class of the invention. In addition, the specification states that the antibodies can be administered for the treatment of various disorders, but fails to provide a correlation to the predisposition of a particular disease and the polypeptide to which the antibody would be made against. Further experimentation is required before this asserted utility is substantial.

The instant application has failed to provide guidance as to how one of skill in the art could use the claimed invention in a way that constitutes a specific or substantial utility. The proposed uses of the claimed invention are simply starting points for further research and investigation into potential practical uses of the claimed polypeptide.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 119-131 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 119 and 124 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are indefinite in the recitation, the antibody that binds and the antibody which specifically binds. Absent a definition of "specific binding" it is not clear what the difference between the two claims is and what each claim is meant to encompass, given that antibody binding is determined by the variable regions structure and is a "specific" event.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina M. DeBerry whose telephone number is (571) 272-0882. The examiner can normally be reached on 9:00 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMD
3/15/04

Elyabeth C. Kemmerer

ELIZABETH KEMMERER
PRIMARY EXAMINER